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10/776,095	02/11/2004	Craig D. Johnson	68.0230CNT1	2344

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EXAMINER	
COLLINS, GIOVANNA M	
ART UNIT	**PAPER NUMBER**
3672	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/776,095	JOHNSON ET AL.	
	Examiner	Art Unit	
	Giovanna M. Collins	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *29-36 and 43-79* is/are pending in the application.

4a) Of the above claim(s) *59-73* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *29-36,43-58 and 74-77* is/are rejected.

7)☒ Claim(s) *78 and 79* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 February 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 29-36,43-58, and 74-79, drawn to expand sand screen, classified in class 166, subclass 227.

   II. Claims 59-73, drawn to method of making an expandable sand screen, classified in class 29, subclass 592.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the invention of Group I can be made by forging.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Jeffrey Griffin on August 4, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 29-36,43-58, and 74-79. Affirmation of this election must be made by applicant in replying to this Office action. Claims 59-73 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 46 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In dependent claim 46, the applicant omitted the claim from which claim 46 depends

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 30-36 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 27-33 of prior U.S. Patent No. 6,695,054. This is a double patenting rejection.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 29 and 74 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 27 and 37 of U.S. Patent No. 6,695,054. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application limitations although broader are obviously met by the patent.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 29 is rejected under 35 U.S.C. 102(a) as being anticipated by International Application WO00/08301 to Metcalfe, et al.

Metcalfe discloses (see Figs.1-2) a system for improving the collapse resistance of an expandable device comprising an expandable tubular system (10) for use in a wellbore environment, the expandable tubular system having a first layer overlapping a second layer (near element 32); and a locking mechanism (see Fig. 1, at 28), wherein upon expansion of the expandable tubular system, the locking mechanism facilitates maintaining the expandable tubular system in the expanded condition.

10. Claims 48-49 and 51 are rejected under 35 U.S.C. 102(e) as being anticipated by Castano-Mears et al. (6,457,518)

Castano-Mears discloses (see Fig. 8a-8b) a system for filtering in a wellbore environment, comprising: a sand screen having a plurality of expandable filter sections (80) and at least one seal section (82), wherein the plurality of expandable filter sections are longitudinally separated by the at least one seal section.

Referring to claim 49, Castano-Mears discloses the at least one seal section (82) comprises a plurality of seal sections.

Referring to claim 51, Castano-Mears discloses the at least one seal section (82) has an expansion ratio at least as great as the expansion ratio of the plurality of expandable filter sections (see fig. 8B).

11. Claims 43-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Lauritzen et al. (6,571,871).

Lauritzen discloses (see Fig. 4) a method of utilizing a sand screen within a wellbore, comprising delivering a sand screen (210) to a wellbore region having a nonuniform diameter, applying (at 100) an expansion force to the sand screen in a radially outward direction; and expanding the sand screen to substantially eliminate any annulus between the sand screen and the wellbore region having the nonuniform diameter.

Referring to claim 44, Lauritzen discloses expanding comprises creating contact between the sand screen (210) and a wall defining the wellbore region.

Referring to claim 45, Lauritzen discloses expanding comprises applying an outwardly directed force (by element 100) against the wall with the sand screen.

Referring to claim 46, Lauritzen discloses wherein expanding comprises expanding the sand screen (210) into the wellbore region (200) having two dissimilar diameters.

Referring to claim 47, Lauritzen discloses applying comprises moving an expansion tool (100) through an interior of the sand screen.

12. Claims 74-75 are rejected under 35 U.S.C. 102(b) as being anticipated by Donnelly (5,901,789).

Donnelly discloses (see fig. 1) a system for filtering in a wellbore environment, comprising: a base pipe (3); a shroud (5) disposed around the base pipe; and a plurality of filter sheets (4) in which each filter sheet has a free end, wherein the free ends of adjacent pairs of filter sheets are positioned in an overlapping configuration.

Referring to claim 75, Donnelly discloses each filter sheet (4) has a plurality of slotted openings (see col. 5, lines 14-18).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

14. Claim 50 is rejected under 35 U.S.C. 103(a) as being obvious over Castano-Mears ('518).

Castano-Mears discloses the system of claim 48 but does not disclose the seal section is an elastomeric material. However, Castano does disclose the section is made of a material that is readily stretchable (see col. 8, lines 30-36). As one of ordinary skill in the art is that elastomeric material is readily stretchable, it would be obvious to one of ordinary skill in the art to modify the system disclosed by Castano-Mears to have the seal section be made of an elastomeric material.

15. Claims 52-58 are rejected under 35 U.S.C. 103(a) as being obvious over Donnelly ('789) in view of Whitlock (6,382,318).

Donnelly discloses a method of controlling filtration in a wellbore environment, comprising: arranging an expandable tubular system (Fig. 1) with overlapping filter sheets (4); Donnelly discloses the filter sheets have uniquely configured openings but does not disclose positioning uniquely configured openings in each overlapping filter sheet such that upon

expansion of the expandable tubular system the overlapping filter sheets create a predetermined flow path regime. Whitlock teaches that it is well known in the art to position filter sheets in order to create a predetermined flow path (see col. 5, lines 51-60). As one of ordinary skill in the art would be familiar with arranging filter sheets to create a predetermined flow, it would be obvious to one of ordinary skill in the art to modify the method disclosed by Donnelly to positioning uniquely configured openings in each overlapping filter sheet such that upon expansion of the expandable tubular system the overlapping filter sheets create a predetermined flow path regime as taught by Whitlock.

Referring to claim 53, Whitlock teaches positioning comprises selecting the predetermined flow path regime to create a pressure drop that varies along the length of the expandable tubular system (see col. 5, lines 51-60).

Referring to claim 54, Whitlock teaches positioning comprises selecting the predetermined flow path regime to create a greater restriction to flow in specific regions of the expandable tubular system relative to other regions of the expandable tubular system (see col. 5, lines 51-60).

Referring to claim 55, Donnelly discloses the filter sheets are metal foil (see col. 5, lines 12-13).

Referring to claim 56, Donnelly discloses the filter sheets can be different shapes but does not disclose that adjacent sheets have different shapes. However, Whitlock discloses that adjusting the structure of adjacent sheets selectively direct flow in certain areas is well known in the art (see col. 5, lines 51-60). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention modify the method disclosed by Donnelly to change the shape of the

adjacent filter sheets as suggested by Whitlock because adjusting the structure of the filter layers to direct the flow is well known in the art.

Referring to claim 57, Donnelly discloses the filter sheets can have slots but does not disclose that adjacent sheets have slots at different angles. However, Whitlock discloses that adjusting the structure of adjacent sheets selectively direct flow in certain areas is well known in the art (see col. 5, lines 51-60). Therefore it would be obvious to one of ordinary skill in the art at the time of the invention modify the method disclosed by Donnelly to change the angles of the slots of the adjacent filter sheets as suggested by Whitlock because adjusting the structure of the filter layers to direct the flow is well known in the art.

Referring to claim 58, Donnelly discloses comprises forming the uniquely configured openings such that the openings in a first sheet (4) overlap the openings in a second sheet to create a unique combined openings upon expansion of the expandable tubular system.

16. Claims 76-77 are rejected under 35 U.S.C. 103(a) as being unpatentable over Donnelly ('789) in view of Whitlock ('318) and Donnelly (6,315,040).

Donnelly ('789) as modified discloses the system of 75. Donnelly does not disclose the slots of adjacent sheets are criss cross. Whitlock teaches that it is well known in the art to position filter sheets in order to create a predetermined flow path (see col. 5, lines 51-60). Donnelly ('040) teaches a filter system that uses a criss cross pattern (see Fig. 3). As one of ordinary skill in the art would be familiar with the filter system having a criss cross pattern and positioning filter sheets in order to create a predetermined flow path is well known in the art, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify

the system disclosed by Donnelly ('789) to have the slots of adjacent sheets in a criss cross pattern as suggested by Donnelly ('040) and Whitlock.

Allowable Subject Matter

17. Claims 78-79 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Giovanna M. Collins whose telephone number is 703-306-5707. The examiner can normally be reached on 6:30-3 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David J. Bagnell can be reached on 703-308-2151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

gmc

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